

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/039,481	Applicant(s) ALMOG, YAACOV	
	Examiner Christopher RoDee	Art Unit 1795	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 47-58 and 63-66.
- Claim(s) withdrawn from consideration: 59-62.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Christopher RoDee/
 Primary Examiner
 Art Unit: 1795

Continuation of 3. NOTE: the proposed amendment requires further search and consideration, including the consideration of possible new matter because the toner particles would be limited to a chargeability of about 103 pmho/cm. This value is far narrower than previously considered (previously less than or equal to 103 pmho/cm) but also includes values larger than 103 pmho/cm because of the relative "about" language. This also raises an issue of possible new matter because it is unclear if the specification provides basis for values above 103pmho/cm. The other amendments also require further search and consideration because they limit the chargeability to the same value for the pigmented polymers (see claim 47 as proposed).

Continuation of 11. does NOT place the application in condition for allowance because: the remarks are primarily directed to the unentered amendments and therefore are moot because the amendment has not been entered. With respect to the 103 rejection and the use of Metcalfe and Wagner in the same rejection, applicants' stress that the documents are not combineable because, as it is understood, Wagner distinguishes itself from Metcalfe noting column 5, l. 32-43. A review of the rejection of record shows that Metcalfe is relied upon for its teaching that pigmented particles do not necessarily have the requisite charge for a liquid developer and Wagner is relied upon for its teaching that coatings on particles are known to change the surface charging characteristics of a particle in a liquid developer. These references are relied upon for background purposes, a general understanding of the art, and the problems faced. This general understanding at the time the instant invention was made (not at the time of Metcalfe and Wagner) motivates the artisan to look to other document to provide the desired charge to a particle in a liquid developer by surface coating. The EP document provides a specific example of such a coating. The Examiner also must point out that the challenge to the rejection on this basis is not timely presented. The Wagner and Metcalfe references cited, the findings of fact concerning these reference, and the reason for the application and combination (i.e., conclusion of law) were the same in the earlier appeal as they are now. The BPAI made a decision affirming the rejection involving these reference and their combination. In other words, the BPAI affirmed the Examiner's finding of fact and conclusion of law concerning these references and their applicability together as well as with Whitbread, Diamond, and the EP reference. Applicants had the opportunity at the time of the appeal to bring the currently presented ground of traversal forward at that time, but did not. The opportunity for consideration of this argument is not timely in this application.